

Remarks

This Amendment is in response to the Office Action dated **October 29, 2007**, wherein: the Office rejected claims 38 – 41 and 43 – 55 under 35 U.S.C. § 112, first paragraph; the Office objected to claim 42 for lacking a status identifier; and the Office rejected claims 38 – 41 and 43 – 55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,911,732 to Hojeibane (hereafter “Hojeibane”).

Claims 38 and 46 have been amended. No new matter has been added. A status identifier accompanies Claim 42.

The following comments are presented in the same order and with headings corresponding to those set forth in the Office Action.

Claim Rejections—35 U.S.C. § 112

The Office rejected claims 38 – 41 and 43 – 55 under 35 U.S.C. § 112, first paragraph, alleging the same as failing to comply with the written description requirement. In the Office Action, the Office asserted that the “drawings cannot be relied upon for disclosing relative proportions of elements of the device.” (Office Action, pg. 2). Based on the MPEP and the case law cited in the paragraph immediately below, Applicant submits, respectfully, that this statement is an incorrect interpretation of the Office’s guidelines and the law.

MPEP § 2125 states:

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the **precise proportions** of the elements and may not be relied on to show **particular sizes** if the specification is completely silent on the issue.”). However, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977) (**emphasis added**)

Applicant has not made “arguments based on measurement of the drawing features,” (MPEP § 2125) and has not relied on the drawings to “define the precise proportions of the elements,” (*Hockerson-Halberstadt*, 222 F.3d at 956), or “to show particular sizes,” (*Id.*). Applicant is not relying on the proportions in the relevant figures in the instant application as

“evidence of actual proportions” (MPEP § 2125). That is, Applicant has not relied on any measurements, precise proportions, or particular sizes with regards to the relevant figures in the instant application in order to support the previous amendments to the claims. There is no measurement, particular size, precise proportion, or actual proportion in the limitation “each of the at least one coil segments extending along a greater longitudinal distance than each of the at least one serpentine segments,” as recited in claim 38. Rather, Applicant is merely relying on what would be clear to a person of ordinary skill in the art reviewing the relevant figures in the instant application: each coil segment is longer than each serpentine segment.

To that end, Applicant asserts that claims 38 – 41 and 43 – 55 comply with the written description requirement under 35 U.S.C. § 112, first paragraph. Applicant requests that the rejection be removed.

Claim Objections

In the Office Action, the Office objected to claim 42 for lacking a status identifier. Applicant has added a status identifier to claim 42, as presented above, to indicate its previously canceled status. Applicant apologizes for any confusion caused by this typographical error.

Claim Rejections—35 U.S.C. § 102

The Office provided a heading and a cite to § 102, but rejected no claims under this section.

Claim Rejections—35 U.S.C. § 103

The Office rejected claims 38 – 41 and 43 – 55 under 35 U.S.C. § 103(a) as being unpatentable over Hojeibane. Applicant respectfully disagrees.

Regarding Claim 38 and Those Claims Dependent Therefrom

Stent Having Both Balloon Expandable And Self-Expanding Segments

Hojeibane fails to teach or suggest all the elements of amended claim 38, namely

the limitation amended as follows: “wherein either the coil segment is balloon expandable and not self-expanding and the serpentine segment is self-expanding and not balloon expandable, or the coil segment is self-expanding and not balloon expandable and the serpentine segment is balloon expandable and not self-expanding.¹”

Applicant asserts that Hojeibane has no disclosure of using, in the same stent, a coil segment that is **balloon expandable and not self-expanding** and a serpentine segment that **is self-expanding and not balloon expandable**, or a coil segment that **is self-expanding and not balloon expandable** and a serpentine segment that **is balloon expandable and not self-expanding**, as in claim 38.

Dependent claims are non-obvious if the claims from which they depend are non-obvious. Claims 47 – 41, 43 – 45, and 54 – 55 depend from independent claim 38. Therefore, claims 39 – 41, 43 – 45, and 54 – 55 are also non-obvious. Applicant respectfully requests that the rejections be withdrawn and that claims 38 – 41, 43 – 45, and 54 – 55 be allowed.

Longer Coiled Sections

Regarding the Office’s argument that it “would have been obvious to have made the coiled sections longer as Hojeibane discloses that the coiled sections can be varied to increase flexibility,” Applicant respectfully disagrees.

First, Applicant incorporates by reference the arguments put forth in the Response filed August 23, 2007. Second, Applicant submits that the issue is not whether it “would have been obvious to have made the coiled sections longer,” as stated by the Office, but instead is whether it would have been obvious to make each coiled section longer than each serpentine section. To this issue, the Office has failed to provide any teaching, suggestion, or motivation in either Hojeibane or in the knowledge generally available to one of ordinary skill in the art to modify Hojeibane in the manner described, as required to make out a prima facie case of obviousness. MPEP § 706.02(j). As such, claim 38 is non-obvious.

Dependent claims are non-obvious if the claims from which they depend are non-obvious. Claims 47 – 41, 43 – 45, and 54 – 55 depend from independent claim 38. Therefore,

¹ Support for the amendment may be found at least at paragraph [0010] in the instant application’s original specification.

claims 39 – 41, 43 – 45, and 54 – 55 are also non-obvious. Applicant respectfully requests that the rejections be withdrawn and that claims 38 – 41, 43 – 45, and 54 – 55 be allowed.

Regarding Claim 46 and Those Claims Dependent Therefrom

Stent Having Both Balloon Expandable And Self-Expanding Segments

For at least the reasons presented above with respect to claim 38, Hojeibane fails to teach or suggest all the elements of amended claim 46, namely at least the following amended limitation: “wherein either the coil segment is balloon expandable and not self-expanding and the serpentine segment is self-expanding and not balloon expandable, or the coil segment is self-expanding and not balloon expandable and the serpentine segment is balloon expandable and not self-expanding.”

Dependent claims are non-obvious if the claims from which they depend are non-obvious. Claims 47 – 53 depend from independent claim 46. Therefore, claims 47 – 53 are also non-obvious. Applicant respectfully requests that the rejections be withdrawn and that claims 46 – 53 be allowed.

Longer Coiled Sections

Regarding the Office’s argument that it “would have been obvious to have made the coiled sections longer as Hojeibane discloses that the coiled sections can be varied to increase flexibility,” Applicant respectfully disagrees.

First, Applicant incorporates by reference the arguments put forth in the Response filed August 23, 2007. Second, Applicant submits that the issue is not whether it “would have been obvious to have made the coiled sections longer,” as stated by the Office, but instead is whether it would have been obvious to make each coiled section longer than each serpentine section. To this issue, the Office has failed to provide any teaching, suggestion, or motivation in either Hojeibane or in the knowledge generally available to one of ordinary skill in the art to modify Hojeibane in the manner described, as required to make out a prima facie case of obviousness. MPEP § 706.02(j). As such, claim 46 is non-obvious.

Dependent claims are non-obvious if the claims from which they depend are non-obvious. Claims 47 – 53 depend from independent claim 46. Therefore, claims 47 – 53 are also non-obvious. Applicant respectfully requests that the rejections be withdrawn and that claims 46 – 53 be allowed.

Conclusion

For at least the reasons presented above, Applicant submits that the Application is in condition for allowance. Favorable consideration and early action to that effect are solicited earnestly.

Should the Examiner have any questions regarding the above Amendment, the Examiner is invited to contact the Applicant's undersigned representative at the number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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